

AO 120 (Rev. 3/04)

TO: Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
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In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Middle District of Florida, Tampa on the following ☐ Patents or ☒ Trademarks:

DOCKET NO. 8:08-cv-1641-T-33TGW	DATE FILED 8/21/08	U.S. DISTRICT COURT Middle District of Florida - Tampa Division
PLAINTIFF First Advantage Corporation		DEFENDANT First Advantage Realty and Finance, Inc.
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 See attached complaint		
2 3,161,546		
3 3,377,146		
4		
5		

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading			
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK		
1				
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK Sheryl L. Loesch	(BY) DEPUTY CLERK Lisa Bingham	DATE 8/23/08
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Copy 1—Upon initiation of action, mail this copy to Director Copy 3—Upon termination of action, mail this copy to Director
Copy 2—Upon filing document adding patent(s), mail this copy to Director Copy 4—Case file copy

UNITED STATES DISTRICT COURT
MIDDLE DISTRICT OF FLORIDA
TAMPA DIVISION

FIRST ADVANTAGE CORPORATION,

Plaintiff,

v.

CASE NO.

**FIRST ADVANTAGE REALTY AND
FINANCE, INC.,**

Defendant.

**COMPLAINT AND DEMAND FOR JURY TRIAL,
INJUNCTIVE RELIEF SOUGHT**

Plaintiff, First Advantage Corporation, a Delaware corporation ("Plaintiff"), by and through its undersigned attorneys, sues Defendant First Advantage Realty and Finance, Inc., a California corporation ("Defendant"), and as its Complaint states as follows:

Nature of Action

1. This is a civil action for trademark infringement and unfair competition arising under the federal Lanham Act, 15 U.S.C. §§ 1114 and 1125(a), and Florida state common law. Plaintiff is a leading risk mitigation and business solutions service provider with tens of thousands of global clients. For over at least the last five years, Plaintiff has continuously operated under and sold services under its FIRST ADVANTAGE® trademark. Plaintiff uses its FIRST ADVANTAGE® trademark for a vast variety of services, including, but not limited to, credit inquiry and consultation and mortgage, background and financial services. Plaintiff became aware that, despite its common law rights and federal trademark registration for FIRST ADVANTAGE® and its long prior use of the FIRST ADVANTAGE® trademark, Defendant

began using the term FIRST ADVANTAGE for brokerage, lending and other related financial services. Despite Plaintiff's demands, Defendant has refused to cease and desist from its infringement and unfair competition.

Parties

2. Plaintiff, First Advantage Corporation, is a corporation duly organized and validly existing under the laws of the State of Delaware, with a principal place of business in St. Petersburg, Pinellas County, Florida.

3. On information and belief, Defendant, First Advantage Realty and Finance, Inc., is a corporation duly organized and validly existing under the laws of the State of California, with its principal place of business in Fair Oaks, Sacramento County, California.

Personal Jurisdiction

4. On information and belief, Defendant has at all times relevant hereto transacted business nationwide, including, but not limited to, in Florida.

5. On information and belief, Defendant has a Florida Mortgage Broker Business License and targets the consuming public in Florida via its advertising and does business in Florida.

6. Defendant has, by virtue of its soliciting and doing business in Florida and its other below-described acts of infringement and unfair competition in this judicial district, subjected itself to jurisdiction in this judicial district pursuant to Florida Stat. § 48.193.

Venue

7. Venue is proper in this judicial district pursuant to 28 U.S.C. § 1391(b)(1) because Defendant has subjected itself to personal jurisdiction in this judicial district (see 28 U.S.C. § 1391(c)), and pursuant to 28 U.S.C. § 1391(b)(2) because a substantial part of the

events or omissions giving rise to the claims asserted in this Complaint occurred in this judicial district.

Subject Matter Jurisdiction

8. The claims of trademark infringement and unfair competition asserted in Counts I and II of this action arise under the provisions of the Lanham Act, 15 U.S.C. § 1051 *et seq.* This Court has original jurisdiction over these claims pursuant to 15 U.S.C. § 1121(a) and 28 U.S.C. § 1338(a).

9. The state law claim of common law unfair competition asserted in Count III of this Complaint is so related to the claims asserted in Counts I and II of this Complaint that they form part of the same case or controversy under Article III of the United States Constitution. This Court has supplemental jurisdiction over these claims pursuant to 28 U.S.C. § 1367(a).

10. This Court also has original jurisdiction over the state law claim of common law unfair competition asserted in Count III of this Complaint pursuant to 28 U.S.C. § 1332(a)(1) because Plaintiff and Defendant are citizens of different states and the amount in controversy exceeds \$75,000.00, exclusive of interest and costs.

Common Factual Allegations

11. Plaintiff is a leading business solutions provider that offers a wide variety of business solution services under its FIRST ADVANTAGE® trademark. For example, Plaintiff offers everything from mortgage, credit, specialty finance and other related services to background investigations, tax consulting, litigation consulting, due diligence, data recovery, multifamily, supply chain security, transportation and lead generation services, as well as the managing of drug testing programs.

12. Plaintiff was featured as one of *Fortune's* 100 Fastest Growing Companies for 2007 and has tens of thousands of clients globally.

13. Plaintiff has spent a great amount of time and funds on its FIRST ADVANTAGE® trademark, which it has used continuously since at least as early as January 2003, resulting in a substantial amount of goodwill and consumer recognition.

14. Plaintiff is the owner of the following trademarks and registrations with the United States Patent and Trademark Office ("USPTO"), true and correct copies of the certificates for which are attached hereto as Exhibits A and B.

a. FIRST ADVANTAGE (Registration No. 3,161,546) for "management of drug testing programs for others" in Class 35; "credit inquiry and consultation; financial investigation of potential tenants" in Class 36; and "background investigation services, namely, conducting pre-employment background investigations, personnel investigations, criminal record investigation, driving record investigation, motor vehicle records reporting, reference verification, education verification and license and certification verification" in Class 45.

b. FIRSTADVANTAGE FACTS FIRST. (and design) (Registration No. 3,377,146) for "business consultation and information services; business inquiry, investigation, evaluation, appraisal, information, and research services; tax and taxation planning advice, information, and consultation services; development of and consultation with respect to shipping and packaging policies and procedures to mitigate the risk of cargo loss and damage; vehicle fleet management services; delivering car buyer leads to car dealerships; delivering loan leads to lenders; development, production, and processing of electronic employment applications; development of, consultation with respect to, review, management, and operation of drug-free workplace policies and programs; development of, consultation with respect to, review, management, and operation of employee assistance programs dealing with any personal issue that might affect worker productivity" in Class 35; "credit and financial consultation, evaluation, and reporting services" in Class 36; "storage of electronic employment applications; storage of fingerprints" in Class 39; "providing employment applications as online documents" in Class 41; "development and provision of driver qualification systems, namely, providing a nondownloadable online tool whereby users can monitor commercial drivers for compliance with Department of Transportation rules and regulations; computer services, namely, data recovery services" in Class 42; "drug testing for substance abuse; driver screening services to ensure that commercial drivers are physically qualified to meet Department of Transportation rules and regulations" in Class 44; and "development of and consultation with respect to supply chain security programs, namely, loss exposure and countermeasure analysis for cargo theft exposure on a lane-by-lane or country-by-country basis and facility risk assessment and emerging market assessments; litigation consultation and support services; pre-employment, pre-renting, and other background inquiry, investigation, evaluation, information, research, and screening services; private investigation

services; fingerprinting services, namely, processing and management of fingerprints; providing motor vehicle and driver background records" in Class 45.

These registrations are valid and subsisting, and have not been cancelled, revoked or abandoned.

15. Plaintiff also is the owner of the following trademarks and applications pending with the USPTO. True and correct printouts of the status of these applications from the USPTO are attached hereto as Exhibits C and D.

a. FIRST ADVANTAGE TALENT ACQUISITION SOLUTIONS (Serial No. 77/384,261) for "business consultation and information services; business inquiry, investigation, evaluation, appraisal, information, and research services; tax and taxation planning advice, information, and consultation services; vehicle fleet management services; development, production, and processing of electronic employment applications; development of, consultation with respect to, review, management, and operation of drug-free workplace policies and programs; development of, consultation with respect to, review, management, and operation of employee assistance programs dealing with any personal issue that might affect worker productivity" in Class 35; "credit and financial consultation, evaluation, and reporting services" in Class 36; "storage of electronic employment applications; storage of fingerprints" in Class 39; "providing employment applications as online documents" in Class 41; "development and provision of driver qualification systems, namely, providing use of a non-downloadable online tool whereby users can monitor commercial drivers for compliance with Department of Transportation rules and regulations" in Class 42; "drug testing for substance abuse; driver screening services to ensure that commercial drivers are physically qualified to meet Department of Transportation rules and regulations; development of, consultation with respect to, review, management, and operation of workplace substance abuse policies and programs" in Class 44; and "pre-employment, pre-renting, and other background inquiry, investigation, evaluation, information, research, and screening services; fingerprinting services, namely, processing and management of fingerprints; providing motor vehicle and driver background records" in Class 45.

b. FIRST ADVANTAGE TALENT MANAGEMENT SOLUTIONS (Ser. No. 77/384,253) for the identical services as FIRST ADVANTAGE TALENT ACQUISITION SOLUTIONS (Serial No. 77/384,261).

16. From June 2003 to July 2008, Plaintiff's revenues made under its FIRST ADVANTAGE® trademarks total about \$3.5 billion. During that same time frame, Plaintiff has spent about \$67.3 million on marketing and \$43.5 million on advertising, all under its FIRST ADVANTAGE® trademarks.

17. As a result of Plaintiff's sales and advertising of its services under its FIRST ADVANTAGE® trademarks, the widespread sale and rendition of such services to the public under the FIRST ADVANTAGE® trademarks, and the quality of the services sold and rendered under the FIRST ADVANTAGE® trademarks, such services have come to be, and now are, well and favorably known to the trade and public under the FIRST ADVANTAGE® trademarks. The FIRST ADVANTAGE® trademarks are a means by which such services are identified as being sold and rendered by Plaintiff.

18. As a result of Plaintiff's sales and advertising of its services under the FIRST ADVANTAGE® trademarks, the widespread sale and rendition of such services to the public under the FIRST ADVANTAGE® trademarks, and the quality of the services sold and rendered under the marks, valuable goodwill in the business as represented by the FIRST ADVANTAGE® trademarks has been generated. The goodwill is symbolized by the FIRST ADVANTAGE® trademarks, and Plaintiff is the owner of the goodwill and the trademarks.

19. Despite Plaintiff's common law rights and federal trademark registrations for FIRST ADVANTAGE® and FIRSTADVANTAGE FACTS FIRST. (and design)® and its long prior use of the FIRST ADVANTAGE® trademarks, Plaintiff became aware that Defendant recently began using the term FIRST ADVANTAGE for brokerage, mortgage, real estate, financial and other related services.

20. On information and belief, Defendant is advertising and selling its mortgage broker, lending and financial services through the website < <http://1starf.com/home.html> >.

21. Plaintiff already has been contacted by a consumer, mistakenly believing that Plaintiff was Defendant or associated with Defendant.

22. Upon discovering Defendant's infringing use of the term FIRST ADVANTAGE, Plaintiff's counsel sent a cease and desist letter to Defendant, a true and correct copy of which is attached hereto as Exhibit E. Although Defendant called Plaintiff's counsel one time, stating that an attorney would be contacting them, neither Plaintiff nor its counsel has since heard from Defendant or an attorney on behalf of Defendant, despite Plaintiff's counsel's follow up emails and telephone calls, and Defendant has persisted in its wrongful use and infringement of the FIRST ADVANTAGE® mark.

23. By virtue of the foregoing, Defendant is infringing upon Plaintiff's FIRST ADVANTAGE® trademarks and unfairly competing with Plaintiff. Defendant's use in connection with its business of the term FIRST ADVANTAGE is likely to, and already has, caused confusion, mistake or deception among the trade and the public.

24. Despite Plaintiff's cease and desist demands, Defendant has intentionally, actively and deliberately refused to comply, has not ceased and desisted from its wrongful use of the term FIRST ADVANTAGE and has intentionally and deliberately persisted in its infringement of Plaintiff's trademark rights and unfair competition with Plaintiff.

25. Defendant's infringement of Plaintiff's trademarks and unfair competition is causing irreparable injury to Plaintiff, and, unless the injunction sought in this Complaint is granted, will continue to cause irreparable injury to Plaintiff due to the confusion, mistake or deception that will be generated among the trade and the public. Plaintiff has suffered and will continue to suffer damage, the exact amount of damage being unknown to Plaintiff at this time. The damage to Plaintiff is, and will continue to be, irreparable because, among other reasons, of the continuing nature of the trademark infringement and unfair competition, which would necessitate a multiplicity of suits for damages if the continuance of the wrongs is not enjoined.

26. All conditions precedent to the institution and maintenance of this action have occurred or been performed by Plaintiff.

27. Plaintiff has engaged the law firm of Shumaker, Loop & Kendrick, LLP to represent it and has obligated itself to pay its attorneys a reasonable fee for their services in this action.

COUNT I

Federal Trademark Infringement

28. Plaintiff realleges paragraphs 1 through 27 of this Complaint as if fully restated herein.

29. This is an action for an injunction arising under 15 U.S.C. §§ 1114 and 1116, and for damages arising under 15 U.S.C. §§ 1114 and 1117.

30. Defendant has, by virtue of its above-described acts, infringed upon Plaintiff's rights in its federal trademark registrations in violation of 15 U.S.C. § 1114.

31. Defendant's above-described acts of infringement have been committed, and are continuing to be committed, with the knowledge that its above-described mark is intended to be used to cause confusion, or to cause mistake, or to deceive.

32. Defendant's above-described acts of infringement have caused irreparable injury to Plaintiff and will continue to cause irreparable injury to Plaintiff if Defendant is not restrained by this Court from further violating Plaintiff's trademark rights due to the confusion, mistake or deception that will likely be generated among the trade and the public as a consequence of the above-described acts of infringement. Plaintiff has no adequate remedy at law.

33. As a result of the above-described intentional and deliberate infringement of Plaintiff's trademark rights by Defendant, Plaintiff is entitled to an injunction and an award of

Defendant's profits, up to three (3) times any damages sustained by Plaintiff, costs of this action, and attorneys' fees, all as set forth in 15 U.S.C. §§ 1116 and 1117, subject to the discretion of this Court.

COUNT II

Federal Unfair Competition

34. Plaintiff realleges paragraphs 1 through 27 and 29 through 33 of this Complaint as if fully restated herein.

35. This is an action for an injunction arising under 15 U.S.C. §§ 1125 and 1116, and for damages arising under 15 U.S.C. §§ 1125 and 1117.

36. Defendant has, by virtue of its above-described acts, infringed upon Plaintiff's rights in both its FIRST ADVANTAGE® federally registered and common law trademarks and competed unfairly with Plaintiff by falsely designating Defendant's services as originating with Plaintiff or with a concern legitimately connected with Plaintiff in violation of 15 U.S.C. § 1125.

37. Defendant's above-described acts of infringement and unfair competition have been committed, and are continuing to be committed, with the knowledge that its above-described marks are intended to be used to cause confusion, or to cause mistake or to deceive.

38. Defendant's above-described acts of infringement and unfair competition have caused irreparable injury to Plaintiff and will continue to cause irreparable injury to Plaintiff if Defendant is not restrained by this Court from further violating Plaintiff's trademark rights and competing unfairly with Plaintiff due to the confusion, mistake or deception that will likely be generated among the trade and the public as a consequence of the above-described acts of infringement and unfair competition. Plaintiff has no adequate remedy at law.

39. As a result of the above-described intentional and deliberate infringement of Plaintiff's trademark rights and unfair competition by Defendant, Plaintiff is entitled to an injunction and an award of Defendant's profits, up to three (3) times any damages sustained by Plaintiff, costs of this action, and attorneys' fees, all as set forth in 15 U.S.C. §§ 1116 and 1117, subject to the discretion of this Court.

COUNT III

Unfair Competition by Infringement of Plaintiff's Common Law Trademark Rights

40. Plaintiff realleges paragraphs 1 through 27, 29 through 33 and 35 through 39 of this Complaint as if fully restated herein.

41. Defendant has, by virtue of its above-described acts, infringed upon Plaintiff's common law rights in the FIRST ADVANTAGE® trademarks and competed unfairly with Plaintiff by falsely designating Defendant's services as originating with Plaintiff or with a concern legitimately connected with Plaintiff in violation of the common law of Florida.

42. Defendant's above-described acts of infringement and unfair competition have been committed, and are continuing to be committed, with the knowledge that Defendant's use of the term FIRST ADVANTAGE is intended to be used to cause confusion, or to cause mistake or to deceive.

43. Defendant's above-described acts of infringement and unfair competition have caused irreparable injury to Plaintiff and will continue to cause irreparable injury to Plaintiff if Defendant is not restrained by this Court from further violating Plaintiff's trademark rights and competing unfairly with Plaintiff due to the confusion, mistake or deception that will likely be generated among the trade and the public. Plaintiff has no adequate remedy at law.

44. As a result of the above-described intentional and deliberate infringement of Plaintiff's trademark rights and unfair competition by Defendant, Plaintiff is entitled to an injunction and damages.

WHEREFORE, Plaintiff demands judgment against Defendant for:

(a) an injunction preliminarily during the pendency of this action and thereafter permanently enjoining and restraining Defendant, its officers, agents, servants, employees, and attorneys, and all other persons in active concert or participation with them, from infringing Plaintiff's trademark rights and unfairly competing with Plaintiff in any manner whatsoever in connection with the operation of its business, and from continuing to operate their business in any manner tending to confuse or deceive the public into believing that their business is in any way connected with, sponsored by or affiliated with Plaintiff;

(b) an order directing Defendant to file with the Court and serve upon Plaintiff a report in writing under oath setting forth in detail the manner and form in which Defendant has complied with the injunction entered by the Court within thirty (30) days after the entry of the injunction in compliance with 15 U.S.C. § 1116(a);

(c) an accounting of Defendant's profits and an order that the same be paid over to Plaintiff;

(d) up to three (3) times any damages sustained by Plaintiff;

(e) restitution to Plaintiff of any and all money Defendant has acquired by means of unfair competition;

(f) interest on such profits and damages at the highest rate allowed by law;

(g) costs of this action;

(h) attorneys' fees; and

(i) such other relief as the Court may deem just and appropriate.

DEMAND FOR JURY TRIAL

Plaintiff, First Advantage Corporation, by and through its undersigned attorneys, requests a trial by jury on all issues so triable.

Mindi M. Richter

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